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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/686,431

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Dale W. Malik

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AT&T Legal Department - AS

Attn: Patent Docketing

Room 2A-207

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EXAMINER

CHANG, JUNGWON

ART UNIT

PAPER NUMBER

2454

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/686,431	<b>Applicant(s)</b> MALIK ET AL.	
	<b>Examiner</b> JUNGWON CHANG	<b>Art Unit</b> 2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 23,24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to amendment filed on 6/11/10. Claim 21 has been canceled, and new claims 23-24 are added. Claims 1-20 and 22-24 are presented for examination.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/11/10 has been entered.
3. The 101 rejection to claims 14-20 are withdrawn in view of the amendment.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable

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over Bernstein et al, (US 2004/0128356), hereinafter Bernstein, in view of Beyda (US 2003/0229670), Wick et al, (US 2005/0030937), hereinafter Wick.

6. As to claims 1, 9 and 10, Bernstein discloses the invention as claimed, including method comprising the steps of:

determining, with an *instant messaging* (IM enhanced email) and utilizing a processor that is executing the *instant messaging*, an Internet presence of a contact identified in an email message (page 2, 0016-0017, "presence detection by sending...email invitation"; page 1, 0007, "particular user's presence online...presence detection") in response to displaying the email message to a user, wherein the determining comprises comparing an email address of the contract identified to an address book database (page 7, 00124-0131, "compares the source of the email against...list of acceptable senders") at the time that the email message is displayed to the user; and

initiating, by utilizing the processor that is executing the *instant messaging* (instant messaging application) an instant messaging (IM) chat session with the contact in response to determining that the contact is present (page 1, 0007; page 4, 0064, "each recipient is sent an instant message invitation email message").

7. Although Bernstein discloses determining an internet presence of a contact using the IM enhanced email (page 2, 0017-0018), Bernstein does not specifically use terms instant messaging client. Beyda discloses instant messaging client (120, fig. 6; page 2,

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0022, "user's online presence may still be detected or monitored by an instant messaging system"; 0029, "instant messaging server, service or system and thereby capable of detecting or monitoring the online presence"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Beyda because Beyda's teaching would allow a user to be notified of the presence of the intended recipient, as taught by Beyda (page 1, 0004-0005).

8. Bernstein does not specifically disclose retrieving an instant messaging address of the contact identified from the address book databases, and then using the retrieved instant messaging address to determine that the contact is present. Wick discloses retrieving an instant messaging address of the contact identified from the address book databases, and then using the retrieved instant messaging address to determine that the contact is present (page 1, 0013-0015; page 2, 0028-0033). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Wick because Wick's teaching would allow the user to verify if the instant message address (screen name) which is associated with particular email address is available for real-time communication, as taught by Wick (page 0033-0034).

9. As to claims 2-8, Bernstein discloses, wherein the step of initiating the IM chat session comprises the steps of: generating an IM chat window; obtaining information

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from the email message; and displaying the obtained information in the generated IM chat window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user").

10. As to claims 11-13, they are rejected for the same reasons set forth in claims 2-8 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

11. As to claim 14, it is rejected for the same reasons set forth in claim 1 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

12. As to claims 15-19 and 22, they are rejected for the same reasons set forth in claims 1-8 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

13. Claims 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein, in view of Beyda, Wick, further in view of Dalal et al, (US 2002/0065894), hereinafter Dalal.

15. Bernstein discloses displaying the obtained information in the generated IM chat

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window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user"). However, Bernstein does not specifically disclose providing the body of the email message as an IM chat message. Dalal discloses providing the body of the email message as an IM chat message (page 3, 0024, "the body of the email reply becomes the text content of the instant messaging"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Dalal because Dalal's teaching would reduce the time to generate an instant message which has correlation information with the email message, as taught by Dalal (page 3, 0024).

16. Applicant's arguments with respect to claims 1-20 and 22 have been considered but are moot in view of the new ground(s) of rejection.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Daniell et al, US 7,707,254, Caughey, US 7,228,335 disclose address book for integrating email and instant messaging.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUNGWON CHANG whose telephone number is (571)272-3960. The examiner can normally be reached on M-F 6:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUNGWON CHANG/  
Primary Examiner, Art Unit 2454  
August 2, 2010